

Attachment to Interview Summary (paper no. 20090824)

On July 30, 2009, Attorney David Boundy (Reg. No. 36,461) contacted Examiner Susanna Diaz to discuss the instant application. Mr. Boundy explained to Examiner Diaz that, during an interview with the previous Examiner (Examiner Lindsay Maguire) and the Supervisory Patent Examiner (SPE Kambiz Abdi), the previous Examiner had agreed to enter the initial response filed on January 23, 2009 (timestamped 15:43:37) as well as the 28-page supplemental amendment filed on the same day, January 23, 2009 (timestamped 23:06:14). The Examiner pointed out that the Examiner's interview summary (for the interview held on January 22, 2009) explains that the claims submitted on June 4, 2008 were discussed and Applicant compared new claim 190 with original claim 14. The Examiner's interview summary also states, "Applicant will submit an amendment in the future reinstating original claim 14, now cancelled, and then will file an amendment directly afterwards that will include amendments to the reinstated claims, with underlines and square brackets, to clearly indicate the newly amended material." The Examiner pointed out that neither the Examiner's interview summary nor the Applicant's interview summary clearly indicates that the Examiner specifically advised the Applicant to file multiple amendments, much less to present new claims 266-282 followed by a supplemental amendment that not only amends claims 266-282 but further add new claims 283-402. It is not clear why Applicant did not present all of claims 266-402 in their desired format with the first response of January 23, 2009. However, being that Examiner Diaz just recently took over the case and she was not present at the interview held on January 22, 2009, she informed Mr. Boundy that she

would contact Examiner Maguire and SPE Abdi to clarify any agreements made during the interview of January 22, 2009.

Examiner Diaz contacted Examiner Maguire and SPE Abdi and, on July 31, 2009, followed up with Mr. Boundy via a telephone call. Examiner Diaz explained to Mr. Boundy that both Examiner Maguire and SPE Abdi maintain that the interview focused on presenting claims that were directed to Applicant's originally presented (and examined) invention. The Applicant's interview summary adds to the record details about the restriction issues discussed. Examiner Diaz reminded Mr. Boundy that she withdrew the most recently pending restriction requirement (asserted by Examiner Maguire) and she examined claims 266-282 (as presented in Applicant's first response filed on January 23, 2009). There is no evidence on record to indicate that Examiner Maguire and SPE Abdi advised Mr. Boundy to file the initial and supplemental amendment combination as he chose to nor is there any indication on the record that Examiner Maguire and SPE Abdi were aware that new claims 283-402 would be presented in a supplemental amendment. At best, based on both interview summaries (from the Office and the Applicant), Examiner Diaz can envision that Examiner Maguire and SPE Abdi were aware that Mr. Boundy planned to file a set of claims directed to the original invention (e.g., using the subject matter of the originally pending and examined claims) and then file an amendment immediately afterward to amend this particular set of claims, but there is no mention on record of agreement to the addition of claims 283-402 in a supplemental amendment. Barring such an agreement on record, Examiner Diaz looked toward the MPEP for guidance on how to treat the supplemental

amendment. As explained in the non-final Office action issued by Examiner Diaz on July 6, 2009, the supplemental amendment filed on the same day (January 23, 2009) was not entered because none of the following circumstances (from 37 CFR §

1.111(a)(2)) applied:

- (2) Supplemental replies . (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:
 - (A) Cancellation of a claim(s);
 - (B) Adoption of the examiner suggestion(s);
 - (C) Placement of the application in condition for allowance;
 - (D) Reply to an Office requirement made after the first reply was filed;
 - (E) Correction of informalities (e.g., typographical errors); or
 - (F) Simplification of issues for appeal. (Please see MPEP § 714.03(a).)

Mr. Boundy asked Examiner Diaz how he could get the supplemental amendment of January 23, 2009 entered. Examiner Diaz stated that Mr. Boundy could file a proper response to the outstanding non-final Office action, including the subject matter of the January 23rd supplemental amendment in Applicant's next response. The Examiner further explained that she would consider this as a normal amendment, like any other response to non-final rejection, which means that she would double check that there are no issues of election by original presentation (in accordance with guidelines set forth in Chapter 800 of the MPEP) and then proceed accordingly. Mr. Boundy expressed his frustration with the progress of the prosecution of the instant application, alleging that the previous restrictions had not been proper. Examiner Diaz reminded Mr. Boundy that she had withdrawn the most recent restriction requirement. She also explained that any mention of restriction on her part was just meant to convey

how she normally handles any claim amendments and she reassured Mr. Boundy that any restriction she may assert in the future will conform to the restriction guidelines set forth in the MPEP. No restriction requirement is currently pending in the instant application.

Examiner Diaz also apologized if there was any miscommunication in the past between Applicant and the Office; however, she explained that, since she had just recently taken over the case, her understanding of what transpired during any previously held interviews is limited to what was formally documented in the interview summaries. Examiner Diaz also invited Mr. Boundy to contact SPE Kambiz Abdi directly if he wished to clarify any possible miscommunications since SPE Abdi was present at the last formal interview held with Mr. Boundy.

Mr. Boundy also inquired whether it would be feasible to have both of the amendments filed on January 23, 2009 changed to non-entered supplemental amendments, so that the Examiner could consider the claim amendment filed on June 4, 2008 (which had been considered non-responsive by Examiner Maguire). Examiner Diaz explained that she could not do this. The first response to an outstanding Office action typically becomes the formal response. Any response filed thereafter (before another Office action is issued) becomes a supplemental response.

No agreements were reached and the Examiner awaits a formal response from Applicant to the outstanding Office action.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692